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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,009	12/04/2003	Behzad Moslehi	IFOS 12032003	7238

7590 12/14/2005

Jay Chesavage
3833 Middlefield Rd.
Palo Alto, CA 94303

EXAMINER

MOONEY, MICHAEL P

ART UNIT	PAPER NUMBER
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2883

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,009

Applicant(s)

MOSLEHI ET AL.

Examiner

Michael P. Mooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-13 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/3/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Species A Embodiment 2 drawn to claims 10-13, 17-19 in the reply filed on 10/14/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 14-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/14/05.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "said attachment extents" in line 9. There is insufficient antecedent basis for this limitation in the claim.

For the purpose of the rejection below, the said limitation in line 9 will be read as "said attachment extent".

Correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-13, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (6299703).

Chen et al. teaches a device comprising: an expander having an expander extent (fig. 1), a coefficient of expansion, a first attachment, and a second attachment (fig. 1), said attachments separated by an attachment extent (fig. 1); an optical fiber having a grating 12 (fig. 1; Abstract), said grating having a grating extent (fig. 1); said expander positioned around said optical fiber (fig. 1), and said optical fiber grating extent is included in said extent of said attachment extents (fig. 1); said expander bonded to said optical fiber at said first attachment and said second attachment (fig. 1; col. 2 lines 33-45); said expander responsive to a control (fig. 1; col. 2 lines 33-53).

Thus Chen et al. teaches all of the structural limitations of claim 10. Regarding "tunable optical filter" in the preamble, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex Parte Masham, 2 USPQ F.2d 1647 (1987).

Thus claim 10 is rejected.

Chen et al. teaches wherein said control is varying magnetic field (fig. 1; col. 2 lines 33-53; fig. 3). Thus claim 11 is rejected.

Chen et al. teaches where said tunable filter includes a magnetic field generator producing a magnetic field which is coupled to said expander (fig. 1; col. 2 lines 33-53). Thus claim 12 is rejected.

Chen et al. teaches where said generator comprises an coil wound about said magnetic field expander. (fig. 1; col. 2 lines 33-53). Thus claim 13 is rejected.

Regarding claim 17, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex Parte Masham, 2 USPQ F.2d 1647 (1987). Furthermore, no additional structure is evident in claim 17. Therefore, each and every element of the structure implied by claim 17 is rejected by the reasons and references given above. Thus claim 17 is rejected.

Regarding claim 18, although Chen does not explicitly refer to the TbDyFe alloy as stated in claim 18, it would have been obvious to one of ordinary skill to use the said

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TbDyFe alloy in an apparatus such as Chen et al.'s figure 1 apparatus because of the similar magnetostrictive properties of Chen et al.'s Co-Fe magnetotriuctive alloy to the said TbDyFe alloy (e.g., Abstract; col. 2 lines 34-67). Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the said TbDyFe alloy in an apparatus such as Chen et al.'s figure 1 apparatus since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Thus claim 18 is rejected.

Chen et al. teaches where the expander is made from zinc. (col. 2 lines 52-60).

Thus claim 19 is rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Mooney whose telephone number is 571-272-2422. The examiner can normally be reached during weekdays, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

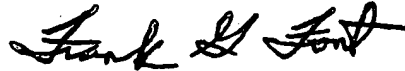
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-

1562.



Michael P. Mooney
Examiner
Art Unit 2883



Frank G. Font
Supervisory Patent Examiner
Art Unit 2883

FGF/mpm
12/6/05